SUPREME COURT, U. S.
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JOHN F. DAVIS, CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1966

No. ~~1956~~ 129

VERNON E. CARLSON [Deceased]
(AMP Incorporated, Assignee)
Petitioner,

v.

ROBERT C. WOOFTER
(General Motors, Inc., Assignee)
Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

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PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

Petitioner, Vernon E. Carlson (by AMP Incorporated, assignee), prays that a writ of certiorari issue to review the judgment of the United States Court of Customs and Patent Appeals, entered in this case on October 27, 1966.

Chronology of Events

The appendix (p. A-1) contains a chronological chart illustrating the time periods when the various acts of the parties occurred.

Opinions Below

The opinion of the Board of Patent Interferences of the United States Patent Office is printed in the appendix, pp. A-1 to A-18. The opinion of the United States Court of Customs and Patent Appeals is printed in the appendix, pp. A-19 to A-43.

Jurisdiction

The judgment of the United States Court of Customs and Patent Appeals was entered October 27, 1966. A timely Petition for Rehearing was denied on February 9, 1967. The jurisdiction of this Court is invoked under 28 U.S.C. § 1256.

Issue Presented

Does the Constitution permit the issuance of a patent to one who is not the first inventor?

Constitutional Provision and Statutes Involved

This case involves Article 1, Section 8, Clause 8, of the Constitution, and Sections 102(a), 102(g) and 115 of the Patent Code of 1952, Title 35 U.S.C. These provisions are set forth in the Appendix, pp. A-44 to A-45.

History

The development of the automobile from the erratic vehicle of the 1930's to the trouble-free vehicle of the 1960's constitutes a dynamic technological

advancement. However, the metamorphosis occurred through a series of thousands of incremental improvements. Contrasting the car of the 1930's that broke down every 500 miles with the car of the 1960's that carries a factory guarantee of 5 years, the reliability is the result of a large number of small improvements.

One of the major areas of improvement is in the electrical system, the nerve center of the automobile. The operation of the car demands that the system supply electricity to various parts of the car, including headlights, spark plugs, etc., for the 5-year/50,000-mile guaranteed life of the car. This continuity must be achieved at high speeds and low speeds, hot weather and cold weather, during severe road vibrations, rain, sleet, ice, dust, etc. Interruption of the circuit might mean loss of lights or disability of the vehicle.

In 1946, petitioner invented a component for the electrical system of automobiles that was inherently trouble-free and insured electrical operation, in spite of the adverse conditions mentioned above. The petitioner at that time was a small company (gross sales, $3 million in 1947) and, looking for post-war, commercial business and hoping to become a supplier to the automotive industry, approached engineers at the General Motors Corporation (gross sales, $3.8 billion in 1947), and naively showed them the invention in the hope they would approve the item for use on General Motors cars.

General Motors was apparently uninterested in improving the quality of its cars at that time. The post-war years were good years for the automotive

manufacturers. There was no need to improve the quality and safety of the cars. General Motors discouraged the petitioner and refused to incorporate the invention in its cars. Petitioner persevered for a number of years, but was continually rebuffed by automotive divisions of General Motors.

Finally, in 1955, halcyon days were over. It again became a buyer's market. General Motors, interested in producing a car with a superior electrical system, adopted petitioner's invention. Instead of acknowledging petitioner's invention, General Motors applied for a patent on a related device and incidentally included a drawing of AMP's invention without any description of what it was or how it worked and without any indication of intent to claim patent rights on the invention. Petitioner then applied for a patent on the invention, and the Patent Office set up interference proceedings to determine who was, in fact, the first inventor.

The Patent Office awarded the patent to the petitioner, AMP, holding that its inventor (Carlson) was the first inventor.

The decision was appealed to the Court of Customs and Patent Appeals which affirmed the holding that the petitioner was the first inventor, but ruled that, because the petitioner had not proved further activity after its completion of the invention and disclosure to the trade, petitioner should be deprived of the patent, and instead the patent should be awarded to General Motors which actively adopted AMP's invention. All this in spite of the fact, recognized by the Patent Office and the Court of Customs and Patent Appeals, that General Motors is not the first inventor.

The question for this Court is whether the Constitution permits the issuance of a patent to a person who, on the record, is, admittedly, not the first inventor.

Reasons for Granting the Writ

(1) THE PUBLIC IMPORTANCE OF THIS CASE IS EXPLICITLY ACKNOWLEDGED IN THE COURT OF CUSTOMS AND PATENT APPEALS' DECISION:

> "This issue [forfeiture] is of *particular public significance* in the context of this case." (Appendix p. A-27; emphasis added.)

(2) THE STATUTORY MONOPOLY GRANTED BY THE PATENT SYSTEM CAN ONLY EXIST IN STRICT CONFORMITY WITH THE PROVISIONS CREATING IT. THE PUBLIC'S INTEREST REQUIRES THAT A PATENT, ISSUED WITH A PRESUMPTION OF VALIDITY, MEET THE REQUIREMENTS OF THESE PROVISIONS.

(3) THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS HAS DECIDED FEDERAL QUESTIONS HEREIN, IN A WAY WHICH IS NOT IN ACCORD WITH THE CONSTITUTION AND THE APPLICABLE DECISIONS OF THIS COURT.

(4) THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS HAS IMPOSED THESE DECISIONS ON THE UNITED STATES PATENT OFFICE, THEREBY FORCING IT TO ISSUE PATENTS WHICH ARE INVALID AB INITIO.

(5) IT IS INCUMBENT UPON THIS COURT TO INTERPRET, FOR THE FIRST TIME, THE CURRENT PATENT

STATUTE'S PROVISIONS AS TO WHEN [IF AT ALL] A VALID PATENT MAY BE ISSUED TO ONE WHO IS NOT THE FIRST INVENTOR.

Development of the Law:

Since the inception of this country, the Constitution has given Congress the power to grant inventors the exclusive right to their discoveries [Article 1, Section 8]. Congress has exercised this power—first in 1790 (the original patent statute), and more recently in 1952, when the current statute was enacted, and in a number of intermediate statutes.

The patent laws were refined and shaped by various amendments, as well as Supreme Court interpretations, to bring the statutes into conformity with the constitutional mandate. The thread running through all these statutes is that only the first and original inventor is entitled to a patent.[1] The "first" inventor is the earliest inventor in point of time. An "original" inventor is one who does not derive the invention from someone else.

One of the problem areas left for judicial interpretation involved the situation wherein two independent inventors filed patent applications on the same invention at approximately the same time in history. The earlier statutes did not provide any specific authority for refusing the patent application of a subsequent

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[1] 35 U.S.C. § 115.

"The applicant shall make oath that he believes himself to be the original and first inventor . . . for which he solicits a patent. . . ."

inventor, in view of a patent application directed to the same invention by an earlier inventor.

As early as 1841, the principle that the patent was to be awarded only to the first and original inventor was established by Mr. Justice Story in the case of *Reed* v. *Cutter*,[2] who said:

> "Under our patent laws, no person, who was not at once the first, as well as the original, inventor, by whom the invention has been perfected and put into actual use is entitled to a patent. A subsequent inventor, although an original inventor, is not entitled to any patent."

An exception to the rule that only the first inventor is entitled to a patent was suggested in 1851, in the case of *Gayler* v. *Wilder*.[3] Mr. Justice Taney interpreted the 1836 Patent Act to mean that if the knowledge of the original discovery was completely expunged from the realm of available scientific knowledge so as to constitute a "lost art," then the second inventor who independently reinvented this knowledge should be entitled to a patent.

The language of the majority was severely criticized in two, vigorous, dissenting opinions. Mr. Justice McLean said:

> "If there be any thing clear in the patent law, it is that the original inventor means the first inventor . . ."; (p. 500)

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[2] *Reed* v. *Cutter*, 1 Story 590 (1841); 20 Fed. Cas. 435.

[3] *Gayler* v. *Wilder*, 51 U.S. 477 (1851); 13 L. Ed. 504.

and Mr. Justice Daniel stated,

> "I have always understood it to be indisputable law, that wherever an inventor abandons or surrenders an invention or improvement which he has certainly made, and neither claims an exclusive right in himself nor transfers it to another, the invention or improvement is given to the public. . . ." (p. 507)

The basic rule was re-established in 1856,[4] to the effect that the failure of the first inventor to file a timely patent application inures to the benefit of the public who puts it into use. The distinction was crystallized in 1859, in the case of *Kendall* v. *Winsor*,[5] when the Supreme Court held that, if the second inventor independently made the invention and then disclosed it to the public, either by issuance of a patent or by public use, then the first inventor would not prevail. This was reaffirmed twice in 1877;[6] again in 1878;[7] and again in 1883.[8] This has been codified into the present law in 35 U.S.C. § 102(g).[9] The

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[4] *Ransom* v. *City of New York*, 20 Fed. Cas. 286 (1856).

[5] *Kendall* v. *Winsor*, 62 U.S. 322 (1859); 16 L. Ed. 165.

[6] *Consolidated Fruit Jar* v. *Wright*, 94 U.S. 92 (1877); 24 L. Ed. 68.

U. S. Rifle & Cartridge v. *Whitney Arms*, 118 U.S. 23 (1877); 6 Sup. Ct. 950.

[7] *Bates* v. *Coe*, 98 U.S. 31 (1878); 25 L. Ed. 68.

[8] *Boyd* v. *Cherry*, 50 Fed. 279 (1883).

[9] 35 U.S.C. § 102 and § 102(g).

> "A person shall be entitled to a patent unless . . . before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there

general rule, that forfeiture by the first inventor inures to the benefit of the public rather than the second inventor, was preserved; note *Marsh* v. *Sayles*[10] (1872), and *Coffin* v. *Ogden*[11] (1874).

In 1898, in the case of *Mason* v. *Hepburn*[12] (the principal case relied upon by the Court of Customs and Patent Appeals in arriving at its decision), the Circuit Court of Appeals for the District of Columbia was faced with a hard set of facts and proceeded to make bad law.

In that case, the first inventor, Mason, made the invention and did nothing further. He did not manufacture it, he did not file a patent application, he never revealed it to anyone. Then, Hepburn independently invented the same invention and filed a patent application. The patent issued to Hepburn, and he began manufacture and sale of the invention. After the patent issued, Mason filed a patent application and attempted thereby to take the patent away from Hepburn and charge him with infringement. The Court of Appeals for the District of Columbia awarded the patent to Hepburn on the basis of the equities of the situation.

Actually, it was not necessary to award the patent to Hepburn to do justice. The Court should have

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shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other."

[10] *Marsh* v. *Sayles*, 16 Fed. Cas. 818 (1872).

[11] *Coffin* v. *Ogden*, 85 U.S. 120 (1874); 21 L. Ed. 821.

[12] *Mason* v. *Hepburn*, 13 App. D.C. 86 (1898).

merely ruled that Mason was not entitled to a patent because he abandoned the invention to the general public.

The Supreme Court has ruled that such forfeiture accrues to the general public rather than the later "inventor." Supreme Court cases,[13] previous to *Mason* v. *Hepburn*,[14] established this principle. Supreme Court cases, subsequent to *Mason* v. *Hepburn*,[15] affirm it. The Court of Customs and Patent Appeals has not seen fit to acknowledge these Supreme Court cases.

The first Supreme Court case subsequent to *Mason* v. *Hepburn*,[16] *Alexander Milburn Co.* v. *Davis-Bournonville Co.*[17] (1926), decided by Mr. Justice Holmes, held that the second "inventor" was not entitled to a patent since, to issue a patent to a subsequent inventor, would be contrary to the spirit of the patent law.

Again, in 1928, the Supreme Court ruled on the inappropriateness of awarding a patent to a second "inventor" in the case of *Corona Cord Tire* v. *Dovan Chemical*.[18] A chemical, known as "D.P.G.," was invented by Dr. Kratz in 1916, but he did not apply for a patent. He confined the use of it to his laboratory

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[13] See notes 3, 5-7 and 11 supra.

[14] See note 12 supra.

[15] *Ibid.*

[16] Ibid.

[17] *Alexander Milburn Co.* v. *Davis-Bournonville Co.*, 270 U.S. 390 (1926); 46 Sup. Ct. 324; 70 L. Ed. 651.

[18] *Corona Cord Tire* v. *Dovan Chemical*, 276 U.S. 358 (1928); 72 L. Ed. 610.

and his lecture room. He abandoned the use of it because it could not then be manufactured commercially. The patentee (Weiss) independently "invented" D.P.G. at a later date (i.e., 1919), and filed a patent application in 1921.

The Supreme Court held that, because Dr. Kratz made the invention before Weiss, under the law Weiss was not entitled to a patent. The Court's decision approved the doctrine of applying a forfeiture in favor of the general public rather than a second "inventor." Mr. Chief Justice Taft laid any apparent conflict to rest with the language:[19]

> "It is doubtless true that Kratz by his course in respect to his discovery as to the use of D.P.G. has abandoned any claim as against the public for a patent, but that is a very different thing from saying that it was abandoned as against a subsequent discoverer or patentee."

Subsequent cases reaffirm the principle that the second inventor is not entitled to a patent: *Marconi Wireless Telegraph* v. *United States*,[20] and *Hazeltine Research* v. *Brenner, Comr. Pats.*[21] (quoting *Alexander Milburn Co.* v. *Davis-Bournonville Co.*[22]).

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[19] Id. at 384, 385.

[20] *Marconi Wireless Telegraph* v. *United States*, 320 U.S. 1 (1943); 63 Sup. Ct. 1393.

[21] *Hazeltine Research* v. *Brenner, Comr. Pats.*, 382 U.S. 252 (1965); 86 Sup. Ct. 335.

[22] See note 17 supra.

Application to the Present Case:

Relating the above development of the law to the present case, it is obvious that the decision of the Court of Customs and Patent Appeals awarding the patent to one who is not the first inventor is contrary to the basic constitutional provisions providing a basis for issuance of patents.

On the record, petitioner has been held to be the first inventor. This finding is specifically set forth in the Patent Office decision:

> "For the above reasons we are of the opinion that the Carlson [petitioner] terminal or connector was actually reduced to practice at AMP by its construction, testing, and offer for sale in the summer of 1946, prior to the record date of Woofter [respondent], and prior to any proven activity by him." [Appendix, p. A-14]
>
> * * * *
>
> "The testimony in question relates to the activity during the period 1946-1950 of the witness as manufacturer's representative for AMP [petitioner's assignee] in Eastern Michigan in showing to possible customers including several divisions of GM [respondent's assignee] terminal samples such as Carlson exhibit 9-D corresponding to a drawing, Carlson exhibit 5, dated 4/19/46, which is within the counts in issue." [Appendix, p. A-16]

The holding was affirmed by the Court of Customs and Patent Appeals:

> "There is no doubt but that AMP actively

engaged in offering this connector for sale during this period. Accepted at its face value, the testimony of Spenser offered on behalf of AMP shows it was active during the period 1946-1950 in trying to stimulate commercial interest in the AMP connector." [Appendix, p. A-32]

* * * *

"Our review of the record leads us to the conclusion that AMP's 1946 tests were sufficient to establish a reduction to practice of connectors meeting the counts of the interference." [Appendix, p. A-34]

* * * *

"The tests conducted by AMP apparently established to its satisfaction that the 1946 connector was a salable item and some considerable effort was made to introduce the connector to the market." [Appendix, p. A-35]

Thus, the lower tribunals found that petitioner had not only conceived and reduced to practice the invention in issue, but had offered it to the public, including respondent, long before respondent had any conception of it. General Motors tried to suppress this testimony,[23] but fortunately, it was unsuccessful.

None of the cases cited in *Mason* v. *Hepburn*[24] sanctions the award of a patent to one who is not the first inventor when two applications are involved. They merely hold that, in such a situation, the first inventor is not entitled to a patent, and the general

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[23] "Subsequently Woofter brought a motion to suppress the entire deposition of Spenser . . ." [Appendix, p. A-16]

[24] See note 12 supra.

public is entitled to use the invention without hinderance of any valid patents.

Contrary to the Supreme Court's decisions, a pocket of law sprung up in the Court of Appeals for the District of Columbia around the turn of the century. Beginning with *Mason* v. *Hepburn*,[25] the Court of Appeals then extended the doctrine in *Matthes* v. *Burt*.[26] The court in that case compounded the error by applying the *Mason* v. *Hepburn*[27] doctrine in an interference between two patent applications. (Remember that, in every previous case, the second inventor had issued a patent before the first inventor filed his application.) The court cited numerous, previous decisions[28] ostensibly in support of this principle. An examination of the cases cited reveals that not a single one of them involved two pending applications.

In the instant case, the Court of Customs and Patent Appeals has failed to distinguish between the first inventor who exposed the invention to the relevant segment of the public, and thus gave the public a vested right, and one who "abandoned or concealed" to withhold his invention from the public.[29] The Court of Customs and Patent Appeals specifically found that petitioner was commercially promoting the in-

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[25] *Ibid.*

[26] *Matthes* v. *Burt*, 24 App. D.C. 265 (1904).

[27] See note 12 supra.

[28] *Consolidated Fruit Jar* v. *Wright*, supra note 6.
Bates v. *Coe*, supra note 7.
Reed v. *Cutter*, supra note 2.

[29] *Kendall* v. *Winsor*, supra note 5.

vention long before respondent allegedly "reinvented" it:

> "There is no doubt but that AMP actively engaged in offering this connector for sale during this period. . . ." [Appendix, p. A-32]

Petitioner's conduct in exposing the invention to the purchasing public (in fact, exposing it to the respondent) dictates that if any forfeiture has occurred, it is to the public's benefit[30] and not the respondent, who tried to discourage the early promotion of the invention, then hide its adoption, and now asserts ownership of the patent.

The Court of Customs and Patent Appeals feels constrained to follow these cases of the Court of Appeals for the District of Columbia, in spite of later Supreme Court cases to the contrary; e.g., *Corona Cord Tire* v. *Dovan Chemical*;[31] *Marconi Wireless Telegraph* v. *United States*.[32] The Court of Customs and Patent Appeals has strait-jacketed the Patent Office into issuing patents to the second inventor.

Conclusion

Unless this Court takes jurisdiction, the Court of Customs and Patent Appeals will force the Patent Office to continue to award patents illegally to patentees who are admittedly not the first inventors of the subjects matter of the patents. This Court's

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[30] *Marsh* v. *Sayles*, supra note 10.

[31] *Corona Cord Tire* v. *Dovan Chemical*, supra note 18.

[32] *Marconi Wireless Telegraph* v. *United States*, supra note 20.

ruling on the issue is necessary to guide the Patent Office and the lower courts in the determination of the validity of patents.

It behooves this Court to decide the issue once and for all. In view of the 1952 patent statute and the currently-proposed legislation,[33] it is important to the general-public welfare and the orderly management of the patent system that the Supreme Court give direction to the Court of Customs and Patent Appeals and the Patent Office on the constitutional question of whether or not a valid patent may issue to the second inventor.

A petition for a writ of certiorari should be granted.

Respectfully submitted,

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[33] S.1042.

Chronology of Events

COMPARISON CHART

AMP	General Motors
1946	
March, 1946 Carlson conceived the invention, disclosed his conception to his draftsman and assistant at AMP and ordered drawings and samples made.	
March-April 1946 Drawings and samples made by AMP.	
Summer, 1946 Reduction to Practice, Distributed samples to the trade.	
1947	
1948	
1949	
1946-1950 Showed and demonstrated samples to prospective users, showed sample connectors to auto industry including various divisions of General Motors; and, specifically, to a Mr. Johnson, an engineer with GM's Packard Electric Division; Mr. Litherland, an engineer with GM Truck and Coach Division, Mr. Richards of GM's Truck and Coach Div.	
	Nov. 29, 1949 Showing of invention added by E. L. Johnson, an engineer of GM's Packard Electric Div., to Woofter's drawing (Exhibits G and H).

AMP	General Motors
1950	
1950-1954 Proof of AMP activity during this period seemed unnecessary, as AMP relied on its proof of prior reduction to practice and prior disclosure to GM and others.	*Feb. 9, 1950* Alleged conception by Woofter. *March 20, 1950* Alleged reduction to practice by Woofter. *1950-1954* GM developing the invention in secrecy for its own profit.
1953	
Dec. 29, 1953 AMP filed first patent application disclosing the invention.	
1954	
Feb. 23 and March 3 AMP representatives asked Packard El. Div. of GM for disclosure of the 1955 Chevrolet connector so AMP could make mating connector for others, but GM refused. GM's claim that AMP then or previously knew of GM's adoption of the invention is based wholly on the testimony of Packard's Chief Engineer that "I *think* the *existence* of *our terminal* would be common knowledge in the market place by that time", but that no proof was offered that GM had given out enough information to apprise AMP that the invention in issue here was to be used by GM.	GM's Hopkins, (the engineer first called on by the AMP men) and Wolcott, Chief Engineer at GM's Packard Div., who received the AMP men on March 3, both produced memos made at the time which record the belief of AMP's men that they could get enough disclosure of GM's connector for design "so that they could make these terminals and sell them in strips to people outside of GM"; but that GM "corrected this impression" and "did not give any encouragement" that "there might still be a possibility of making a deal . . . so that they could furnish terminals to other people outside our plant."

AMP

Dec. 16, 1954 AMP filed the Carlson application, with drawings, written description and claims to the invention.

General Motors

April, 1954 GM filed the Woofter application concerned here, but without any written description of the invention nor any claim to the invention and having as its only relation to the invention a copy of one figure of the drawing made by Johnson in 1949 after AMP's disclosure to GM.

1957

January, 1957 Patent office held AMP's claim to patent on the invention allowable, but suggested to GM that they make the same claim and contest with AMP.

March 8, 1957 GM copied AMP's allowed claim into its Woofter application. Thus the first written description and the first claim on the invention ever made in a GM application, was at least 7 years after disclosure of the invention to GM by AMP.

April 22, 1957 to present both applications tied up in interference proceeding.

Opinion of Board of Patent Interferences of the United States Patent Office

Paper No. 115

Final Hearing
December 2, 1963

GWB/dlr

IN THE UNITED STATES PATENT OFFICE

BEFORE THE BOARD OF PATENT INTERFERENCES

Patent Interference No. 88,609

CARLSON v. WOOFTER

Electrical Connector

Application of Vernon E. Carlson filed December 16, 1954, No. 475,733

Application of Robert C. Woofter filed April 28, 1954, No. 426,118

Messrs. Curtis, Morris and Safford, Mr. Marshall M. Holcombe, Mr. William Hintze, Mr. William J. Keating and Mr. Frederick W. Raring for Carlson.

Mr. G. H. Willits, Mr. G. H. Strickland, Mr. Craig V. Morton and Mr. W. E. Finken for Woofter

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This interference involves two applications. The junior party Carlson is involved on the basis of his application

Opinion of Board of Patent Interferences of the United States Patent Office

No. 475,733, filed December 16, 1954, assigned to AMP Incorporated (hereinafter AMP) while the senior party Woofter is involved on the basis of his application No. 426,118, filed April 28, 1954, and assigned to General Motors Corporation (hereinafter GM).

Both parties took testimony, filed briefs and were represented at the final hearing. Carlson as junior party has the burden of proving priority of invention by a preponderance of the evidence.

The interference originally involved three counts but by decision on motion the interference was dissolved as to count 2 and count 4 was added. Also a third party, Long, was added to the interference but was later removed by a motion to dissolve granted by the Primary Examiner.

The subject matter in issue is a female electrical connector stamped out of sheet metal and is sufficiently described in count one which is representative and reads as follows:

Count 1

> A sheet metal electrical connector comprising a wire gripping portion and a terminal clip, said clip including a web having a contact surface thereon, opposed overhanging spring members extending from the longitudinal sides of said web and having terminal edges overlying and spaced from said contact surface to engage yieldingly therewith a contact blade, the longitudinal side portions of said web being concavely bowed so as to extend, from the web portion including said contact surface, first downwardly and then upwardly in integral continuity with said spring members respectively.

Before entering a consideration of the evidence submitted, two contentions of Carlson must be disposed of.

First, Carlson contends that we have no jurisdiction for the reason that,

> There was no application by Woofter for patent on the subject matter of the counts of this interference and no suggestion of any reason for, or special significance in, the configuration shown in his Figure 5. (Carlson brief, page 36.)

The basis for this statement appears to be a belief on the part of Carlson that the Woofter application does not include a description of the structure here in issue and did not include a claim thereto until claims suggested by the examiner were presented. He urges that because of these circumstances it was improper for the Primary Examiner to have suggested the claims in view of cited portions of the Manual of Patent Examining Procedure.

Whether or not the suggestion of the claims to Woofter was in accordance with the instructions in the "Manual," the claims were in fact asserted by Woofter and thus he is presently claiming the invention within the requirements of rule 201. So far as this contention amounts to a contention that the counts in issue are not patentable in the application of Woofter by virtue of deficiencies of that application aside from the question of support for the limitations in the count, it amounts to an attack on the patentability of the counts which is not ancillary to priority and may not be considered by us under rule 258. See also Glass v. De Roo et al., 44 CCPA 723; 1957 CD 103; 239 F 2d 402; 112 USPQ 62.

As to the question of Woofter's right to make the count, Carlson urges that the portion of the Woofter specification relied on does not describe the structure defined by the counts and further urges that Figure 5 of the Woofter drawing shows only a cross-section at one plane and that

nothing in the drawings shows that the critical configuration recited in the counts extends any substantial distance beyond the plane of the section. This latter is not an accurate statement. First, Figure 5 is an end view, not a cross-section. It is not cross-hatched and in the description of the figures of the drawing on page 2 of the Woofter specification Figure 5 is stated to be an end view of Figure 3. Further, on the preceding page, page 2, Figure 3 is stated to be a plan view of the female terminal of Figure 1. Therefore in evaluating the disclosure of the Woofter drawing we must examine Figures 1 and 3 as well as Figure 5. It is clear from Figure 1 that the line bounding the lowest surface of the female terminal has substantial length and extends as far as the depressed tongue 40. It is evident therefore, that the trough-like portions shown in end view in Figure 5 do conform to the requirements of the counts and are not merely spherical bulges as Carlson speculates on page 44 of his brief.

Woofter refers to the paragraph bridging pages 3 and 4 of his specification as relating to the structure in question. We agree that this does not describe the initial downward curving of the wing portions except by reference to Figure 5 of the drawing. However, the Court of Customs and Patent Appeals in the case of Padgett v. Warner, 26 CCPA 1403, 1939 C.D. 789, 104 F 2d 957, 42 USPQ 152, stated:

> As appellee's rollers are so arranged that they are free to move longitudinally in the cups, as clearly appears from the drawings in appellee's application, it is immaterial, so far as the issue here is concerned, that no reference was made in appellee's application to such longitudinal movement.

We think that a similar statement is applicable here, and that the Woofter application discloses the structure recited in the counts in issue in terms. We further are of the opinion that the functional statement at the end of count 4 is inherently satisfied by the structure shown in Woofter Figure 5.

In view of our conclusion that Woofter can make the counts in issue we must now consider the priority evidence adduced on behalf of Carlson. This comprises the testimony of six witnesses supported by documentary and physical exhibits. The party Carlson had died prior to the taking of testimony.

For proof of conception Carlson relies primarily on his exhibit 1 and the testimony of the witness Tippett relating thereto. During the period in question Tippett was acting chief draftsman at AMP. Carlson exhibit 1 was identified by Tippett as an inventor's sketch showing a terminal for use on a sealed beam headlight and which he signed as a witness. The sketch shows a female terminal clip substantially similar to that disclosed in the involved Carlson application. Woofter does not contend that the counts in issue do not read on the terminal there disclosed but urges that the testimony of Tippett is insufficient to establish conception, contending that Razanski who made the sketch did not testify.

We are of the opinion that this contention is without merit. Tippett identified Carlson's signature on the sketch as well as his own and verified the date, which is given as "3-7-46". Woofter has noted an inconsistency in that a production drawing, Carlson exhibit 4, is dated "3-5-46." Tippett also testified to the effect that although Carlson did not draw the sketch of exhibit 1, he sketched it on a "doodle pad" which he himself saw. It is clear from other testimony discussed below that later in 1946

sample terminals substantially in accordance with the exhibits mentioned were actually made at AMP. Cf. Borglin v. Palmer, 21 CCPA 1109, 1934 CD 467, 70 F 2d 899, 21 USPQ 587. While Carlson's proofs might be strengthened by testimony by the actual draftsman we do not believe that it is essential. It is our opinion that the evidence reviewed above is sufficient to establish conception by Carlson in March of 1946. We do not deem it significant that the production drawing was dated slightly prior to the inventors sketch.

Carlson's exhibit 9-B is of prime importance with respect to his case for an actual reduction to practice. This exhibit was identified by Tippett as a harness for an automotive sealed beam headlight. It comprises a three-wire cable and a connector comprising an insulating housing having three slots each having associated therewith a female terminal clip of the type disclosed in Carlson exhibits 1 and 4, already mentioned. From a drawing of a "TERMINAL HOLDER," Carlson exhibits 8-A and 8-B, Tippett identified a date stamp on the back "Apr 9, 1946" initialed by him and indicating receipt in the engineering department. He also stated that this is a print of the housing or holder of the harness of exhibit 9-B and that the harness was made up the same day or within at most three days from the date stamp on exhibit 8-B.

The harness Carlson exhibit 9-B was sent to the sales department after a test with a battery and a sealed beam headlight. Tippett assigned someone to perform the test but did not remember who it was. He stated that he observed the test and that "the lights did light using this harness." (Tippett record p. 45, Q160 and p. 46 Q169.) During the taking of his testimony Tippett repeated the test using allegedly the same circuit of which he drew a diagram, Carlson exhibit 12. It appears that upon opera-

tion of the dimmer switch only one section of the light lit up until some adjustment was made by Mr. Marvin who was present as of counsel for Woofter. In response to cross-examination (XQ 538, Carlson record 106, 107) Tippett stated:

> No, I disagree with you. He picked up the headlamp element which was laying at an angle, which bent the wire conductors back here. As soon as he turned it up this way, then it did operate here in this manner.

In colloquy between counsel, Mr. Raisch and Mr. Marvin indicated disagreement with that statement but neither testified as a witness and such statements of disagreement can be given no evidentiary weight.

Tippett also testified (Carlson record p. 51, Q179 through Q182) that prior to sending the harness to the sales people he tried the harness on a sealed beam unit for fit and retention. He concluded,

> It did not wobble or you couldn't shake it off. It was a tight fit—that is to the point it could be removed, but it also would be retained.

He stated that the harness was sent to the sales people in April of 1946 and was returned with a memorandum from Don Porter to Jack Thompson dated 5-15-47, Carlson exhibit 11, in May of 1947. (Carlson record 42, Q146.) It was thereafter kept in a locked file to which only two persons had keys, Tippett and Kerchner, another witness. It was kept there until initiation of the present proceedings.

Kerchner served as checker draftsman under Tippett for the period in question (1946 and 1947). He stated that he checked the drawing, Carlson exhibit 8-A, on

3-12-46 as indicated by his initials near the lower edge. He also recognized several physical exhibits including 9-B, the harness already mentioned. He testified regarding a test of the retentiveness of the terminals of harness, exhibit 9-B as follows:

> Q30. Did you determine that it had an appreciable retentive power? A. Yes, sir, I did.
>
> Q31. What did you do to so determine? A. Well, I lived a little dangerously. I stuck this thing on here and took hold of the harness and shook it. If it wouldn't have stayed on, I would have a busted leg. (Carlson record 315)

Kerchner also testified that he had tried other connectors, Carlson exhibits 9-A and 9-C stating:

> Q37. Did you also try these on the sealed beam unit? A. Yes, I put them on, but I didn't shake it like I did this. This (indicating) seemed too easy to pull off. I didn't take a chance on it. (Carlson record page 316.)

Another witness who testified regarding the harness Carlson exhibit 9-B was Thompson, another AMP employee. Early in 1946 he had been acting as engineering consultant for the sales department but in April of that year he was transferred to the engineering department to act as a project engineer reporting to Carlson. He identified his handwriting on a tag on the harness (Carlson exhibit 9-B) as notes he had made at the time the sample was forwarded to Don Porter (apparently in the sales department). He also identified Carlson exhibit 11 as a memorandum from Don Porter. The memorandum is dated 5-15-47 and addressed to Mr. Jack Thompson. It states that a sample of a seal beam connector was being

returned as the company to which it had been shown had stated that they were not interested in going further with that project. Thompson recognized a handwritten note as his to Tippett indicating that he was to file the sample when it was returned. He testified further to the effect that there was no indication in the correspondence that the sample would not work, and stated:

> If this sample had not worked, it would not have been sent back to the file. It would have been worked on further to improve it. (Carlson record page 262, Q16.)

Thompson testified that at the time he was convinced that the connector of Carlson exhibit 9-B would perform better on a sealed beam headlight than any of the connectors of that type at AMP at that time "simply by means of the analysis of the terminal and the virtue that its pull-off was considerably higher and its contact pressure considerably greater." (Carlson record 279, RDQ77) He went on to state that AMP had obtained similar connector samples from the potential customer and from a local automotive parts distributor. He stated:

> The sample, Exhibit 9-B, had a higher pull-off value from the sealed beam headlight prongs than any of the samples which had been submitted to AMP as representative of what the customer was currently using. (Carlson record page 273, RDQ61.)

He then stated that the high pull-off value was a virtue in itself because it is indicative of higher contact pressure and therefore a better chance of breaking down oxide or other films on the connector parts. Earlier, Thompson had testified as an expert in the connector art that because of the high currents involved in automobile circuits a good

pressure contact is all that is really necessary to constitute a good connector.

In rebuttal, GM introduced the testimony of three witnesses, Lourie, Doane and Falge, of long experience with electrical systems in GM cars. This testimony was to the effect that before GM would adopt a connector it would be tested more rigorously than was the Carlson terminal at AMP, including voltage drop tests over a period of time as well as before and after a series of push-on and pull-offs and successive exposure to high humidity 100 degree temperature and salt spray. This would be followed by inclusion on a car which was road tested on the proving ground. On the basis of this testimony Woofter contends that the tests at AMP were insufficient to amount to a reduction to practice. He urges that the long lapse of time between the activity in 1946 and 1947 until the filing of the Carlson application indicates that that activity was no more than an abandoned experiment, citing authorities of which an example is Kirkham and Rosenberg v. Arden and Merriman, 50 CCPA 1205, 137 USPQ 370. On the other hand Carlson relies on such authorities as Sinko Tool and Manufacturing Company v. Automatic Devices Corporation, 157 F 2d 974, 71 USPQ 199, Neufeld v. Marte, 45 CCPA 888, 1958 CD 268, 117 USPQ 291, 254 F 2d 164, and Schnick v. Fenn, 47 CCPA 1174, 1960 CD 512, 277 F 2d 935, 125 USPQ 567.

The circumstances surrounding the Carlson device are, in our opinion, different from those which were before the court in the Kirkham case, supra, in that after the tests which were performed AMP put the device in the hands of sales personnel and expressed a willingness to produce and sell it. We believe that this brings the present case within the Statement by Judge Learned Hand in the Sinko case supra as follows:

> * * * a test under service conditions is necessary in those cases, and in those only in which persons qualified in the art would require such a test before they were willing to manufacture and sell the invention as it stands.

In determining whether or not the Carlson device was ready for production and sale we do not consider that AMP was bound by the requirements which would have been imposed by GM in accordance with the testimony of Lourie, Doane and Falge. The personnel at AMP were experienced in the field of connectors in general and their approval of the Carlson device is persuasive of a conviction of success sufficient to support a holding of reduction to practice on behalf of Carlson. In reaching this conclusion we have been impressed by the testimony of Thompson (Carlson record 279, 280) comparing the Carlson terminal with others available at the time:

> RDQ77. When you saw Exhibit 9-B in the time before it was filed away, did you form any firm conclusion as to whether it was a satisfactory connector to perform its intended function? A. Yes. I had definitely formed an opinion that this connector would perform better on the sealed beam headlight than any of the connectors that we had at AMP of a similar nature simply by means of the analysis of the terminal and the virtue that its pull-off was considerably higher and its contact pressure considerably greater.
>
> RDQ78. I think I asked you whether you had formed a conclusion and you said you had formed an opinion; is that of different significance? A. No. I am sorry if I used the wrong word.

RDQ79. Was there any real doubt in your mind that it could perform that way? A. Never.

RDQ80. It has been called to my attention that in your second previous answer you said that this connector "would perform better than any of the connectors we had at AMP"; is that what you meant to say? If so, will you explain what connectors you had in mind? A. Yes. In the development of the connector, AMP had obtained not only the samples from the potential customer but had gone to the local automotive parts distributor and obtained some similar parts.

RDQ81. What you meant was the competitive terminals which were then in commercial use, is that right? A. That's right.

Mr. Safford: That is all. Your witness, Mr. Raisch.

We do not consider that this comparison or the comparison made by Kerchner is vitiated by the testimony of the GM witnesses regarding the tests which would have been applied at GM. The latter were apparently based on an exceedingly high standard. Lourie indicated that they were "fussier about our acceptance of a standard than we would in a less critical circuit because headlamp circuits would be a critical circuit." (Woofter record 203, XQ65.) It is noted that the present counts are not limited to headlamp usage so that utility for any purpose would satisfy requirements for actual reduction to practice. Also the same witness indicated that GM maintained higher standards than the people who sell through accessory stores. (Woofter record 206, XQ80).

The GM witness Doane admitted that a prior art terminal termed the "Douglas terminal" had proved inferior

in laboratory tests but had been "used quite a bit by a number of people." (Woofter record 272, XQ63.) This indicates that inferior performance in the GM tests would not necessarily preclude the use of a device. A "Wade Terminal" was also similarly mentioned. Further, it appears that Doane's testimony was predicated at least in part on a necessity for proving the performance of mass production tools. (Woofter record 261, 262, XQ22 through 25.) Difficulties in mass production would be quite pertinent to adoption of a device on a commercial automobile, but are not generally considered to be relevant to satisfactory operation of the device itself. In the case of *Schnick* v. *Fenn* supra the Court of Customs and Patent Appeals did not consider that difficulties in mass producing the cigar lighter which was the invention there in issue negated an actual reduction to practice. Moreover, there is nothing in this record to indicate any actual or anticipated difficulty in this regard. AMP employees clearly were confident that the Carlson terminal could be mass produced since they were thinking in terms of millions of them.

For the above reasons we are of the opinion that the Carlson terminal or connector was actually reduced to practice at AMP by its construction, testing, and offer for sale in the summer of 1946, prior to the record date of Woofter, and prior to any proven activity by him.

Woofter has advanced the contention that if the tests at AMP in 1946 be considered to amount to an actual reduction to practice, Carlson has been guilty of abandonment, concealment and suppression, citing Mason v. Hepburn, 1898 CD 510, 13 App. D.C. 86 (Appeals DC, 1898) and several succeeding cases. It is urged that such a holding is justified because of the delay of eight and one-half years from the first 1946 activity to Carlson's filing

date in December 1954, the deliberate placing of Carlson exhibits 9-B, 9-E, 9-G and 9-K in a steel file which was kept locked and the alleged spurring into activity (filing the Carlson application) of AMP in 1954 by knowledge that GM was going to use the Woofter connector on the 1955 model Chevrolet.

It is well established that mere delay in filing an application is insufficient basis for a holding of suppression or concealment and that the party seeking to avail himself of the doctrine must affirmatively establish the necessary elements thereof. The Court of Customs and Patent Appeals in the case of Gallagher *et al.* v. Smith, 41 CCPA 734, 99 USPQ 132, 206 F 2d 939, cited in Carlson's reply brief, in discussing this doctrine made the following statement:

> Numerous applications, as well as misapplications, of that doctrine have been set forth through the years, but it remains a fundamental principle that mere delay in filing will not suffice, in itself, to defeat the rights of the first inventor. A party seeking to succeed by invoking applicability of the doctrine must affirmatively establish that the elements of concealment and suppression are present in the facts of the particular case under consideration. Requisite proof is essential and it cannot be supplied by an improper over-indulgence in conclusions warped by undue presumptions and inferences.

We do not believe that the keeping of the noted exhibits in a locked file as in the present case can properly be regarded as concealment or suppression. First of all, the exhibit 9-B had already been shown to at least one prospective customer. Moreover, the testimony of Tippett and Kerchner, the custodians of the key, is to the effect

that the exhibits in question as well as other things were merely placed in safekeeping to prevent their being appropriated by some employee, and that anyone who had a valid reason for examining them or taking them out would have been allowed to do so. This is an entirely reasonable precaution. There is no evidence that any person tried to get access to the exhibits and was prevented from doing so.

In this connection we come to another matter. During the period for rebuttal testimony by Carlson the deposition of one Willard Spenser was taken over objection by counsel for Woofter as being improper rebuttal. Subsequently Woofter brought a motion to suppress the entire deposition of Spenser based on that objection. The testimony in question relates to the activity during the period 1946-1950 of the witness as manufacturer's representative for AMP in Eastern Michigan in showing to possible customers including several divisions of GM, terminal samples such as Carlson exhibit 9-D corresponding to a drawing, Carlson exhibit 5, dated 4/19/46, which is within the counts in issue. It is the contention of Woofter that such does not rebut Woofter's priority case and should have been taken as a part of Carlson's testimony-in-chief and therefore was improperly taken during his period for rebuttal testimony. It is also urged that Spenser's testimony is improper rebuttal for the reason that it tends to indicate that Woofter was not an original inventor.

We note that in the paragraph bridging pages 31 and 32 of his brief Woofter states that testimony was taken on his behalf for two purposes, to rebut the case made out by Carlson by his testimony-in-chief, and "to affirmatively establish that the party Carlson's invention was abandoned, suppressed and concealed." The latter amounts

to an acknowledgement that Woofter had the burden of proving affirmatively the contended abandonment, suppression or concealment (see the Gallagher case supra) and that at least a part of his testimony related to that matter. That being the case it seems evident that testimony tending to rebut evidence in the latter category is proper rebuttal testimony. A junior party can hardly be expected in his testimony-in-chief to anticipate and rebut in advance testimony relating to a matter as to which the senior party bears the burden of proof. Accordingly, the Spenser deposition must be regarded as proper rebuttal, at least insofar as it relates to the question of abandonment, suppression or concealment. Insofar as the Spenser testimony may tend to show lack of originality in Woofter, it appears that the objection by Woofter is well taken although at the hearing counsel for Carlson admitted that the record did not establish such lack of originality and indicated that he would not press that contention. For the reasons given Woofter's motion to suppress the Spenser deposition is granted to the extent that we have not considered that deposition insofar as the matter of lack of originality of invention in Woofter is concerned, but is denied insofar as that deposition tends to prove absence of abandonment, suppression or concealment by Carlson.

The evidence already reviewed is believed to negate any suppression or concealment on the part of AMP and the testimony of Spenser concerning the offer to the trade of the Carlson terminal during the period 1946 to 1950 merely strengthens that conclusion. Surely, the fact that a connector within the counts in issue has been shown to a substantial number of possible users over a period of about four years is inconsistent with such suppression

or concealment as would justify the invocation of the doctrine of Mason v. Hepburn.

In view of our conclusions reached above, Carlson is entitled to prevail as the first to reduce to practice. Woofter also filed a motion to amend his preliminary statement but since the earliest dates alleged in his amended preliminary statement are in 1949, subsequent to the reduction to practice on behalf of Carlson, that motion can have no bearing on the outcome of the interference and we regard its consideration as unnecessary.

For the reasons given priority of invention of the subject matter in issue is hereby awarded to Vernon E. Carlson, the junior party.

.....
A. Y. Casanova, Jr.
Examiner of Interferences

.....
George W. Boys
Examiner of Interferences

.....
La Verne Williams
Examiner of Interferences

BOARD OF PATENT INTERFERENCES

Opinion of the United States Court of Customs and Patent Appeals

UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

OCTOBER TERM 1965.

Patent Appeal No. 7496.

Interference No. 88,609.

ROBERT C. WOOFTER,

Appellant,

v.

VERNON E. CARLSON,

Appellee.

October 27, 1966

SMITH, Judge.

Appellant prosecutes this appeal from a decision of the Board of Patent Interferences awarding priority to appellee. The applications involved in the interference are:

(a) Woofter's application S. N. 426,118 filed April 28, 1954, and

(b) Carlson's application S. N. 475,733 filed December 16, 1954.

The subject matter of the interference is a sheet metal electrical connector, or terminal, illustratively shown in Figs. 3 and 4 of its Woofter application as follows:

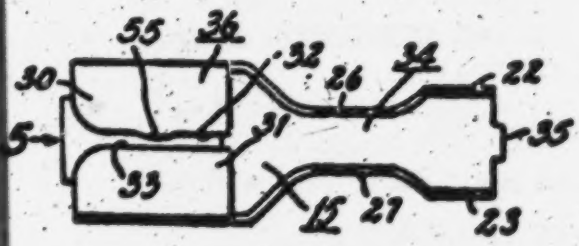

Fig. 3.

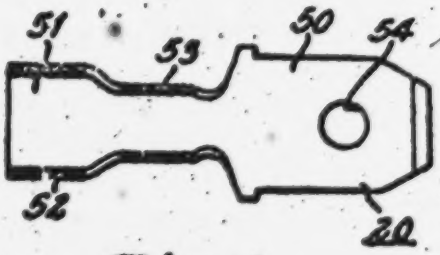

Fig. 4.

The connector includes a female portion formed by the side wings 30 and 31 which are reversely bent upon themselves to place their longitudinal edges 32 and 33 in close proximity to the base 21 so that the spade-type male terminal 20 (shown in Fig. 4) will be received in the female portion and held in conductive electrical contact. The female connector is so formed as to grip the spade terminal under the required spring pressure to obtain such contact pressure as necessary to hold the engaged parts in electrically conductive engagement along a contact surface of substantial area.

The particular feature of the invention in issue relates to the configuration of the spring arms of the female terminal. They are concavely bowed so as to extend from the contact surface (referred to in the counts as the "web portion") first downwardly and then outwardly and upwardly in what is termed "integral continuity." This construction is asserted to improve the electrical conducting properties of the connector by extending the elastic system of the spring arms to the engaged portions of the spade terminal.

The issue of the interference is presented in counts 1,

3 and 4 corresponding to claims 24, 26 and 29[1] of appellant's application which read as follows:

> 1. A sheet metal electrical connector comprising a wire gripping portion and a terminal clip, said clip including a web having a contact surface thereon, opposed overhanging spring members extending from the longitudinal sides of said web and having terminal edges overlying and spaced from said contact surface to engage yieldingly therewith a contact blade, the longitudinal side portions of said web being concavely bowed so as to extend, from the web portion including said contact surface, first downwardly and then upwardly in integral continuity with said spring members respectively.
>
> 3. In an electrical connector, a terminal clip including opposed side wall portions, an integral web connecting said side wall portions, a major transversely centrally located portion of said web being flat for defining a contact surface for the clip, and inwardly directed flanges extending from said side wall portions and overhanging said web, the side portions of said web between the flat central portion and said side wall portions extending downwardly and joining said side wall portions below, relative to said flanges, the plane of said flat central portion.
>
> 4. A terminal clip for electrical connection with a substantially flat contact blade comprising a web

[1] Counts 1 and 3 had originated as claims 3 and 8 of the Carlson application. Original count 2 as presented in Woofter claim 25 had been claim 4 of the Carlson application. In its amended form it becomes claim 29 of the Woofter application and count 4 of the interferenee.

having a contact surface thereon, overhanging spring members extending from opposed sides of said web, the ends of said members overlying and being spaced less than the thickness of the blade from said contact surface for yieldingly pressing the blade against said contact surface, the longitudinal side portions of said web being bowed to extend from the web portion including said contact surface, first downwardly and outwardly and then around the side edges of the blade in integral continuity with the respective spring members for extending the elastic system of said members to include a portion of said web underlying the blade.

The interference as originally declared on April 22, 1957 involved counts 1, 2 and 3. After a decision on motions the interference was dissolved as to count 2. It was reformed on September 22, 1960 by adding count 4. Both parties have taken testimony.

To place this entire controversy in its proper perspective it is noted that the real parties in interest are General Motors Corporation (hereafter "G.M.") as assignee of the senior party Woofter's application and AMP Incorporated (hereafter "AMP") as assignee of the junior party Carlson's application. While the contest is nominally between Woofter and Carlson as applicants, their identities and interests are so merged into the identities and interests of their respective assignees that no useful purpose is served in continuing the fiction inherent in the repeated reference to the nominal parties as if this were a contest between individual inventors. In the present contest they appear as but instrumentalities of their corporate assignees. Since the determinative issue herein relates to the activities of these assignees, we shall

hereafter designate the respective parties by their corporate names. The present contest has been fought vigorously and presently appears to have been but an incident in a broader commercial struggle between these assignees. The significance of this factor will be apparent as we proceed to a resolution of what seem to us to be the central and dispositive issues here involved.

In summary these issues are:

1. Does the record establish a basis for AMP's challenge to the jurisdiction of the Board of Patent Interferences?
2. Did AMP forfeit its right to a patent by its delay in filing the AMP application in interference?

The first issue arises on AMP's motion to dissolve the interference because of alleged insufficient support for the counts in the G.M. application. The AMP position as stated in its brief is:

> Although this interference was set up in a usual way by the Examiner disclosing to Woofter the claims which he was allowing to Carlson, and Woofter copying those claims into his application, it was done without the usual prerequisites; and we submit, therefore, that jurisdiction under the interference section of the Statute, 35 USC 135, could not be acquired. * * *

We shall first dispose of this issue. AMP's contention is that the G.M. application did not contain a *written description* of the invention as required by 35 USC 112, and therefore that there was no lawful application before

the Patent Office at this time. Proceeding from this position AMP's argument is that there was no proper basis for the examiner to suggest the AMP claims to G.M. for purposes of an interference. As stated in its brief the AMP position is that:

> Jurisdiction failed for two reasons: (1) there was no *interference* because Woofter had never given the least indication of applying for patent on the invention of the counts until he was lured into copying them by the Examiner suggesting Carlson's allowed claims "for purposes of interference"; and (2) there is no statutory *application* for patent by Woofter on the invention of the counts.

The particular portions of the counts on which AMP based its motion to dissolve relate to the longitudinal side portions of the web of the female portion of the connector. The pertinent portions of the counts upon which this argument is advanced were underlined in AMP's motion of Nov. 4, 1957 and are here reproduced as follows:

> *Count 1*
>
> • • • the longitudinal side portions of said web being concavely bowed so as to extend, from the web portion including said contact surface, first downwardly and then upwardly in integral continuity with said spring members respectively.
>
> *Count 2*[2]
>
> • • • the longitudinal side portions of said web being bowed to extend, from the web portion including

[2] Count 2 was in the interference when AMP's motion was made. The pertinent portion here referred to also appears in count 4 which later replaced count 2 in the interference.

> said contact surface, first downwardly and outwardly and then around the side edges of the blade in integral continuity with the respective spring members for extending the elastic system of said members to include a portion of said web underlying the blade.
>
> *Count 3*
>
> • • • the side portions of said web between the flat central portion and said side wall portions extending downwardly and joining said side wall portions below, relative to said flanges, the plane of said flat central portion.

It is fundamental to AMP's position that the structure defined in the foregoing portions of the counts.

> • • • results in an elastic and mechanical system of the spring members of the clip of superior performance by virtue of the avoidance of stress concentration by distributing it over a longer length and avoidance of interference with the mating blade side edges during insertion • • •

The issue thus framed requires a consideration of its merits before passing to a consideration of AMP's challenge to the jurisdiction of the board. At the outset it is noted the written specification of the G.M. application contains little in the way of a formal written description of the invention as thus claimed. However, the drawing as filed in the G.M. application shows the mechanical structure of the female connector element as called for in the above quoted portions of the counts. We think one of ordinary skill in this art would know that the longitudinal

overhanging side members would have to be "spring members" to function in the manner called for in the counts.

In what appears to be something of an afterthought, G.M. in the concluding paragraph of its reply brief refers to original claim 7 of its application as support for its position. Inspection of this claim does not support the G.M. position but reveals it to be like the rest of the application in requiring that considerable extraneous information, possessed by one of ordinary skill in the art, be read into it before one can conclude that the overhanging wing structures of this claim are in fact the "spring members" required by the counts.

The test of the right to make counts is to be found in the total disclosure. Thus, the omission of a written description in the specification of an application will not necessarily prevent the reading of a count on a structure shown in the drawing and described in general terms in the specification. Here, the function of the disclosed structure is inherent in the structure shown in the drawings forming a part of the application. Cf. *Wirkler* v. *Perkins,* 44 CCPA 1005, 245 F. 2d 502, 114 USPQ 284; *Ellis* v. *Shaw,* 295 F. 1006, 1924 C.D. 230; *Foss* v. *Ogelsby,* 29 CCPA 1005, 127 F. 2d 312, 53 USPQ 356.

In *Padgett* v. *Warner,* 26 CCPA 1403, 104 F. 2d 957, 42 USPQ 152, this court observed:

> As appellee's rollers are so arranged that they are free to move longitudinally in the cups, as clearly appears from the drawings in appellee's application, it is immaterial, so far as the issue here is concerned, that no reference was made in appellee's application to such longitudinal movement.

It seems clear, therefore, that the Woofter application discloses the structure recited in the counts in issue.

Also, the functional statement at the end of count 4 seems to be *inherently* satisfied by the structure shown in Woofter Fig. 5. Cf. *Henderson* v. *Grable*, 52 CCPA 920, 339 F. 2d 465, 144 USPQ 91.

We think, therefore, that AMP's showing does not establish a sufficient factual basis to support its attack on the jurisdiction of the Board of Patent Interferences. As properly pointed out by the board:

> Whether or not the suggestion of the claims to Woofter was in accordance with the instructions in the "Manual," the claims were in fact asserted by Woofter and thus he is presently claiming the invention within the requirements of rule 201. So far as this contention amounts to a contention that the counts in issue are not patentable in the application of Woofter by virtue of deficiencies of that application aside from the question of support for the limitations in the count, it amounts to an attack on the patentability of the counts which is not ancillary to priority and may not be considered by us under rule 258. See also Glass v. De Roo *et al.*, 44 CCPA 723; 1957 CD 103; 239 F. 2d 402; 112 USPQ 62.

We shall now consider the second issue, did AMP by its delay in filing the Carlson application, under the facts of this case, forfeit its right to a patent?

This issue is of particular public significance in the context of this case. Pertinent to this consideration are the facts that many of the events relied upon by AMP as establishing a reduction to practice occurred some twenty years ago and that the applications of both parties were filed in 1954, some 12 years ago. While responsibility for much of the delay since 1954 can be charged to the

cumbersome and time-consuming interference practice in the Patent Office, there remains AMP's delay which occurred in the prior and crucial period extending from its 1946 reduction to practice to its filing of the Carlson application in 1954.

AMP is here charged with "suppression," "abandonment" and "concealment" of the invention during this period. G.M.'s view of this issue is stated in its brief as follows:

> * * * The patent laws have been enacted for the benefit of the public pursuant to the constitutional provision of Article 1, Section 8. Early disclosure of an invention to the public promotes the progress of the useful arts and the public welfare whereas delay, suppression and concealment defeats the purpose of the law. AMP did not merely delay filing on Carlson's alleged connector for some seven and one-half years, it actually concealed and suppressed the same. Surely the testimony is clear that no member of the public could or would have been given access to the cabinet in which the Carlson connector was concealed. Not even everyone in the connector department of AMP Company was permitted access to the file or cabinet * * *. Only Kerchner and Tippett had keys thereto. Access was restricted to a very limited group of employees of AMP's connector department and as the record stands not everyone even in the connector department was given access to the file during the years 1947-1956. AMP, not Carlson, was the owner of the alleged Carlson connector invention and the real party in interest herein. AMP clearly concealed and suppressed from the public and kept to itself alone, the alleged Carlson connector. This is the

> concealment and suppression the Patent Act condemns because it is patently inimical to the public interest which is always dominant in any patent litigation or controversy.

The facts as stated in the foregoing are not seriously disputed. However, the issues of suppression and concealment to be decided thereon are at the heart of the controversy. Thus, AMP's brief states:

> There is absolutely no evidence of a *deliberate* intent to conceal or suppress; and, as already pointed out, the evidence shows a deliberate intent, implemented by effective action, to bring the Carlson invention and its advantages to the attention of prospective customers with a view to getting into large scale production as soon as possible * * *.
>
> Although it is true that when C[arlson] Ex. 9B was returned from the field, it was put for safekeeping into an "active" customer file * * * in a locked steel filing cabinet, "any person that would want anything for any of the projects" was "let into that file" * * *. Other identical samples of the Carlson connector were sent to Don Porter with C[arlson] Ex. 20 (see fourth line et seq.) and to others before Ex. 9B was completed * * * and others were shown to prospective customers by Spenser; and such showing continued from 1946-50 * * *. Spenser's samples were never returned to AMP * * *. There is not even any basis for a conclusion that the samples sent out in March 1946 to Don Porter on the West Coast and to the others mentioned in C[arlson] Ex. 20, were returned, much less that they were suppressed or concealed in any way. This argument of GM is tantamount to an

> argument that GM suppressed and concealed because of some Chevrolet which was locked up in a garage. GM's attempt to make "suppression and concealment" out of the fact that AMP was prudently careful in preserving these samples, which had been tested and shown to prospective customers, is clearly erroneous, but its use of the word "deliberate" aggravates the error. * * *

Some of the problems which arise in regard to this aspect of the controversy appear to be due to a faulty analysis of the legal requirements. Judge Learned Hand analyzed this aspect of the problem in a different factual context in *Metallizing Engineering Co.* v. *Kenyon Bearing & Auto Parts Co.*, 153 F. 2d 516, 68 USPQ 54 (2nd Cir. 1946). While this decision is not directly in point, we here refer to it because it contains a particularly pertinent statement of the rationale which we think should govern here. Judge Hand there stated:

> * * * it is a condition upon an inventor's right to a patent that he shall not exploit his discovery competitively after it is ready for patenting; he must content himself with either secrecy, or legal monopoly. It is true that for the limited period of two years he was allowed to do so, possibly in order to give him time to prepare an application; and even that has been recently cut down by half. But if he goes beyond that period or probation, he forfeits his right regardless of how little the public may have learned about the invention; *just as he can forfeit it by too long concealment, even without exploiting the invention at all.* Woodbridge v. United States, 263 U. S. 50; Macbeth-Evans Glass

> Co. v. General Electric Company, supra (246 F. 695). *Such a forfeiture has nothing to do with abandonment,* which presupposes a deliberate, though not necessarily an express, surrender of any right to a patent. Although the evidence of both may at times overlap, each comes from a quite different legal source: one, from the fact that by renouncing the right the inventor irrevocably surrenders it; the other, from the fiat of Congress that *it is part of the consideration for a patent that the public shall as soon as possible begin to enjoy the disclosure.* [Emphasis added.]
>
> It is indeed true that an inventor may continue for more than a year to practice his invention for his private purposes or his own enjoyment and later patent it. But that is, properly considered, not an exception to the doctrine, for he is not then making use of his secret to gain a competitive advantage over others; he does not thereby extend the period of his monopoly. Besides, *as we have seen,* even that privilege has its limits, for *he may conceal it so long that he will lose his right to a patent even though he does not use it at all.* * * * [Emphasis added.]

We began this opinion with a reference to the significance of this proceeding as but an incident in an apparent commercial struggle between G.M. and AMP as the real parties in interest. Insofar as pertinent to this phase of the decision, the significant underlying facts are that AMP as early as 1946 had produced and probably distributed samples of a connector meeting the counts of this interference. AMP's connector 9B which was produced in 1947 was placed in a locked cabinet from then until 1954.

Two AMP employees had keys to this cabinet and access to it was restricted to a limited group of employees. No patent application on this connector was filed until December 16, 1954.

There is no doubt but that AMP actively engaged in offering this connector for sale during this period. Accepted at its face value, the testimony of Spenser offered on behalf of AMP shows it was active during the period of 1946-1950 in trying to stimulate commercial interest in the AMP connector. His testimony stops just short of establishing a commercial acceptance of the terminal.

Even assuming that full credence is given to the Spenser testimony, it cannot bear on the issue of suppression of the invention by AMP during the period of 1950-1954. At best it but reduced the delay from an 8 year to a 4 year period. There is no required time period for the loss of right to a patent by suppression of an invention. A suppression if established for a 4 year period is as effective as is one for an 8 year period.

Here AMP seeks to excuse its suppression during the period after 1950 by pleading its dependence on industry acceptance before proceeding either with production or filing of a patent application. One who delays filing his patent application under these circumstances does so at his peril for such conduct also is persuasive of suppression or concealment.

During the time of AMP's activity G.M. had, independently insofar as the present record shows, developed and tested the Woofter connector, decided at least as early as 1954 to use it on its 1955 Chevrolet line, and filed its application on April 28, 1954. Learning of this commercial activity on the part of G.M. (but apparently without being advised of the filing of the G.M. application) AMP representatives called on the Packard Electric

Division of G.M. and discussed a business proposition under which AMP would tool up and manufacture the connectors which the Packard Electric Division was to supply to the Chevrolet Division of G.M.

It is AMP's position as stated in its brief:

> When an interference party has been proven not to be the prior inventor, he is always tempted to raise the issue of abandonment or suppression and stimulation into renewed activity. However, in this case that can offer no escape in view of the facts brought out by McClure, Tippett, Jack Thompson, Spenser and GM's Hopkins, discussed above, proving that AMP had sent samples to the trade through its local representatives; and that, quite the reverse of being stimulated into activity by GM, AMP had for years been trying to stimulate GM to use, and permit use by its suppliers, of the Carlson invention, which had been disclosed to GM before the earliest date alleged by Woofter. • • •

The G.M. position as stated in its brief is:

> • • • the record is clear that AMP never manufactured or sold a terminal as shown in the Carlson application as exemplified by Carlson Exhibit 5 • • •. *However, the record is clear that AMP did, at a date subsequent to Woofter's filing date, and still does, manufacture and sell terminals having a structure in accordance with the counts in issue as exemplified by Woofter Exhibit E and Carlson Exhibits 9L, 9M and 9N* • • •. The striking similarity of these AMP terminals to the terminal structure disclosed in appellant's application is significant and should not go unnoticed. The subsequent copying of the

> Woofter terminal by appellee's employer, AMP, compels a conclusion that appellee's terminal of 1946 and the tests thereof were abandoned, and work was done on a terminal within the scope of the counts in issue only after appellee's employer AMP had learned of appellant's terminal so as to lead to the inescapable conclusion that appellee's 1946 terminal was not reduced to practice by tests sufficient to demonstrate its practical utility, and hence amounted only to an abandoned experiment. * * *

Viewing the same facts, AMP in its brief takes the following position:

> GM, in its brief to this court, contends that AMP was stimulated to rush into the Patent Office with its application. * * * We submit that the facts of this case show just the reverse—GM had seen fit to copy AMP's invention rather than to buy from AMP and had been keeping that secret from AMP. When it found that AMP knew that Chevrolet was getting a new harness, and wanted drawings in order to bid on the connectors, GM considered whether to let AMP know what connector design was to be used, and decided against it. Secrecy was maintained. Having decided against discussing the issue above-board, GM did appear to rush into the Patent Office. (It was a pity AMP did not, as it could have become senior party if it had done so.)

Our review of the record leads us to the conclusion that AMP's 1946 tests were sufficient to establish a reduction to practice of connectors meeting the counts of the interference. While they were not tested as fully as G.M. contends is necessary to establish a reduction to practice of connec-

tors for automobile headlights, the fact is that the counts do not specify any end product use for the connectors. The tests conducted by AMP apparently established to its satisfaction that the 1946 connector was a salable item and some considerable effort was made to introduce the connector to the market. The salient facts are summarized in AMP's brief as follows:

> * * * it is the fact that the terminal was designed for mass production with a contemplated initial order of nine million * * * but the market for replacement harnesses (for which it had been originally designed) had suddenly dried up in 1946 * * *. AMP was confident that after the first boom of post war production would pass, the automobile companies * * * would have to improve their wiring and would come to this, although, because of their manner of operating, the automobile companies are notoriously reluctant to adopt anything new for fear it might increase service problems or be unacceptable to the whims of the purchasing public.
>
> AMP did not give up. It had faith in this terminal and kept it in an active customer file * * * for further reference * * * and it was urged upon GM as long as Spenser was AMP's representative and again as soon as it appeared that GM had reached the point where it was sufficiently interested in better wiring to use it * * *.

On this basis, AMP argues:

> The refusal of manufacturers immediately to adopt an invention excuses delay in applying for patent until that condition can be overcome. *Allen v. Blaisdell*, 39 CCPA 951, 93 USPQ 428-43; 196 F. 2d 527. Here there is strong reason for applying

the rule, because GM itself was delaying AMP by withholding permission to use AMP's Carlson connector while proceeding with its imitation unbeknownst to AMP.

Ordinarily one would take such a statement as a prelude to an attack on originality of the G.M. invention and an assertion of its derivation from AMP. The parties are in agreement, however, that the issue of originality here fails for lack of proof. Thus, AMP's brief states:

> We have not urged any issue of lack of originality in Woofter. We have recognized that there is serious question as to that, but we were unable to find proof sufficient to ask for decision on that ground. If such proof exists it should be in the possession of GM and/or Woofter. On cross-examination of Woofter and his witnesses, we probed for that * * * but we could not follow AMP's disclosure beyond the Packard men to whom Spenser had shown the Carlson samples.
>
> Woofter proved that he had knowledge of the invention soon after he began working with Johnson in a connector design group at Packard * * * but we could not prove that Woofter actually received disclosure of Carlson's invention before it came to his own mind. Spenser's testimony that he had shown the Carlson connector to a Packard engineer named Johnson fell short of the proof required to establish derivation, especially as we could not prove he was the same Johnson who was working with Woofter at the time when Johnson made the earliest drawing in GM's proofs * * * showing the new configuration defined in the counts.

These facts, it seems to us, brings this case squarely within the long-standing rule enunciated in *Mason* v. *Hepburn*, 13 App. D.C. 86 (D.C. Cir. 1898). A summary of the facts found in *Mason* v. *Hepburn* shows its close approximation to the facts here. Mason, an employee of the Winchester Repeating Arms Company, invented a new gun clip for use with magazine-firearms. Although his date of conception was about June 28, 1887, and the court found actual reduction to practice to have occurred shortly thereafter, nothing further was done in connection with the clip, and the working model was stored on the company's premises. Meanwhile, Hepburn, working independently, developed a similar clip without any knowledge of Mason's previous efforts. Hepburn filed his application on April 3, 1894, and the patent duly issued on September 11, 1894. Mason learned of Hepburn's patent and promptly filed his own application for patent on his invention of some seven years earlier. The Patent Office declared an interference and the Commissioner ruled that the evidence did not support a finding of actual reduction to practice by Mason and awarded priority to Hepburn. On appeal, the court took Hepburn's filing date as the date of his conception and reduction to practice. The court also found that Mason had reduced his invention to practice in 1887.

The only significant difference to be noted between the facts in the present case and those in *Mason* v. *Hepburn* is that Mason filed his application after issuance of Hepburn's patent and copied the claim of this patent. It was the issuance of Hepburn's patent which the court found had "spurred" Mason into activity leading to the filing of his application. Here, however, the act which apparently "spurred" AMP into activity in 1954 was not the issuance of a patent but rather was G.M.'s adoption in

1954 of the Woofter connector for its 1955 line of Chevrolet cars. This factual difference is not significant insofar as the principle of *Mason* v. *Hepburn* is concerned. If anything, it is even more in the public interest to reduce the incentive for the type of patent activity here involved lest it give substance to the apprehensions of Mr. Justice Bradley stated in a different factual context in *Atlantic Works* v. *Brady*, 107 U.S. 192, 200 (1882). There Mr. Justice Bradley pointed out:

> • • • an indiscriminate creation of exclusive privileges tends rather to obstruct than to stimulate invention. It creates a class of speculative schemers who make it their business to watch the advancing wave of improvement, and gather its foam in the form of patented monopolies, which enable them to lay a heavy tax upon the industry of the country, without contributing anything to the real advancement of the arts. It embarrasses the honest pursuit of business with fears and apprehensions of concealed liens and unknown liabilities to lawsuits and vexatious accountings for profits made in good faith. • • •

Thus, it seems to us, the public interest in the present controversy is fundamentally the same as that which concerned the court in *Mason* v. *Hepburn*. For this reason we here adopt and apply the principle stated in *Mason* v. *Hepburn*, 13 App. D.C. at 95, that:

> Considering, then, this paramount interest of the public in its bearing upon the question as presented here, we think it imperatively demands that a subsequent inventor of a new and useful manufacture or improvement who has diligently pursued his

labors to the procurement of a patent in good faith and without any knowledge of the preceding discoveries of another, shall, as against that other, who has deliberately concealed the knowledge of his invention from the public, be regarded as the real inventor and as such entitled to his reward.

* * * *

In Bates v. Coe, 98 U.S. 31, 46, the point was not directly involved; but Mr. Justice Clifford, in affirming the right of the inventor to keep his invention secret for any length of time without forfeiting his right to a patent, coupled it with the following exception, * * *: "Unless another in the meantime has made the same invention, and secured by patent the exclusive right to make, use and vend the patented improvement. Within that rule, and subject to that exception, inventors may delay to apply for a patent." See, also, 1 Robinson on Patents, Sec. 390.

In some of the decisions the first inventor is regarded as having abandoned the field to other inventors, whilst in others he is held to have lost his right by sleeping too long upon it.

Strictly speaking, abandonment after the completion of the inventive act applies in a case where the right of the public to the use is involved, and not in one where the contention is between rival claimants merely of the monopoly.

The true ground of the doctrine, we apprehend, lies in the policy and spirit of the patent laws and in the nature of the equity that arises in favor of him who gives the public the benefit of the knowledge of his invention, who expends his time, labor,

> and money in discovering, perfecting, and patenting, in perfect good faith, that which he and all others have been led to believe has never been discovered, by reason of the indifference, supineness, or wilful act of one who may, in fact, have discovered it long before.

AMP, while recognizing the legal implications inherent in its delay in filing the Carlson application, argues:

> The proofs of both parties in this case show a considerable time lapse between conception and filing of the application for patent. The Carlson application was filed December 16, 1954, whereas his reduction-to-practice was in April, 1946 and the conception very shortly prior. The delay is not significant, however, because Carlson's invention was already reduced to practice. *Gallagher et al.* v. *Smith*, 41 CCPA 734, 99 USPQ 132.

It is clear, we think, that our decision in *Gallagher* v. *Smith* should not be so extended to embrace fact situations which are not comparable to the fact situation there in issue. As stated in 41 CCPA at 743, 99 USPQ at 138:

> In its simplest form, the question here may be presented as follows: What evidence of suppression, concealment (and/or abandonment) has the appellant placed before us to warrant a holding that Smith is now estopped from being adjudged, as a matter of fact and law, the first inventor and, as such, entitled to prevail?

After a review of the various reasons advanced to explain the delay in filing in the *Gallagher* case, this court concluded:

> • • • Appellant has not proven by a preponderance of evidence that Smith concealed and suppressed the invention (nor abandoned the same, although we do not believe that appellant seriously contended the affirmative of such result), and we are manifestly unwilling, on the facts of this case, to allow ourselves to substitute what might, at first appraisal, be a clearly warranted presumption in place of the direct proof required by law. In summarizing, it is well to repeat that *a showing of concealment or suppression is not made out by merely establishing the fact of an extended delay in applying for a patent upon an invention previously reduced to practice.* [Emphasis added.]

The *Gallagher* decision is typical of numerous decisions in which courts have sought to avoid forfeiture of an applicant's right to a patent unless a clear case of abandonment, forfeiture or suppression was established. The facts necessary to establish such a case vary in each instance and one can secure from the cases but general guidance to aid in making this determination.

As pointed out in *Frey* v. *Wagner*, 24 CCPA 823, 87 F. 212, 32 USPQ 239, this court has a reluctance to extend the doctrine of forfeiture stated in *Mason* v. *Hepburn* unless the record establishes that there was a concealment or suppression of the invention.

As pointed out in the *Frey* case:

> The burden was upon the appellant to establish among other things, a concealment or suppression on the part of the party Wagner, if the doctrine of *Mason* v. *Hepburn, supra,* is to be applied. • • •

Here G.M. has accepted the burden referred to in the above cases and has established in the present record

facts which establish a concealment or suppression of the AMP invention within the so-called "forfeiture rule" of *Mason* v. *Hepburn* which we find to be here applicable.

The facts here are comparable to those before the court in *Thomson* v. *Weston*, 19 App. D.C. 373 (1902), 1902 C.D. 521. There, after Thomson had established what the court found to be a completed reduction to practice, the instrument was placed in his model room or private laboratory to which outsiders were not admitted. The instrument was seen only by employees who might go to that room but knowledge of the instrument and its use in the model room was confined to Thomson and his assistant Shand. After Weston had received a patent, Thomson filed his application. The court stated, 19 App. D.C. at 380, 1902 C.D. at 527:

> • • • And where one has completed the act of invention his right to the reward in the form of a patent becomes complete save in two instances that may be satisfactorily shown to exist. First, he loses the right as against the public in general by a public use for the statutory period. Second, by deliberate concealment or suppression of the knowledge of his invention he subordinates his claim, in accordance with the general policy of the law in the promotion of the public interest, to that of another and *bona fide* inventor who during the period of inaction and concealment shall have given the benefit of the discovery to the public. Viewed in the light of "the true policy and ends of the patent laws," the latter is the first to invent, and therefore entitled to the reward. • • •

Here, the facts of concealment and suppression of the invention by AMP are very comparable to the facts in

the *Thomson* case. They have been properly proven. These facts clearly support the inference that AMP was "spurred into activity" by its knowledge of G.M.'s commercial activities with the Woofter connector. It was only after AMP had knoweldge of the G.M. commercial activities that it filed its application, nearly 8 years after the alleged reduction to practice of the invention which is here asserted. Under these circumstances, we hold AMP has forfeited its right to a patent. *Mason* v. *Hepburn,* 13 App. D.C. 86 (1898); *Matthes* v. *Burt,* 24 App. D.C. 265 (1904); *Gordon* v. *Wentworth,* 31 App. D.C. 150 (1908); *Miller* v. *Hayman,* 18 CCPA 848, 46 F. 2d 188, 8 USPQ 188.

This resolution of the second issue leads to a reversal of the board's decision on this issue and leaves for determination the question of the apportionment of the costs of printing which has been raised by appellant's motion filed on June 29, 1964. While this appeal might have been determined on the less complete record specified in appellant's praecipe, we have used the material added to the record by appellee in arriving at our decision herein. We think, therefore, it was properly included. Appellant's motion to apportion the printing costs is denied.

REVERSED

WORLEY, C. J., did not participate.

Constitutional Provision and Statutes Involved

Article 1, Section 8, Clause 8:

> "The Congress shall have power . . . To promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries."

28 U.S.C. § 1256. Court of Customs and Patent Appeals; certiorari

> "Cases in the Court of Customs and Patent Appeals may be reviewed by the Supreme Court by writ of certiorari."

35 U.S.C. § 102. Conditions for patentability.; novelty and loss of right to patent

> "A person shall be entitled to a patent unless——
>
> "(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent . . . ,"
>
> • • • •
>
> "(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other."

35 U.S.C. § 115. Oath of applicant

"The applicant shall make oath that he believes himself to be the original and first inventor of the process, machine, manufacture, or composition of matter, or improvement thereof, for which he solicits a patent; and shall state of what country he is a citizen. Such oath may be made before any person within the United States authorized by law to administer oaths, or, when made in a foreign country, before any diplomatic or consular office of the United States authorized to administer oaths, or before any officer having an official seal and authorized to administer oaths in the foreign country in which the applicant may be, whose authority shall be proved by certificate of a diplomatic or consular officer of the United States, and such oath shall be valid if it complies with the laws of the state or country where made. When the application is made as provided in this title by a person other than the inventor, the oath may be so varied in form that it can be made by him."

BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI

[redacted]

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1966

No. 1356

VERNON E. CARLSON, Deceased,
(AMP Incorporated, Assignee)
Petitioner,

v.

ROBERT C. WOOFTER,
(General Motors, Inc., Assignee)
Respondent.

BRIEF IN OPPOSITION TO PETITION FOR CERTIORARI

The issue said to be presented in the petition is whether "the Constitution permit(s) the issuance of a patent to one who is not the first inventor." The true issue, if there really be one, is whether the Congress has the power to define who is the first inventor. The alleged Constitutional issue was not raised, considered, or passed upon below. As we point out herein, the petition should be denied because (1) the ruling below is essentially interlocutory in

character and does not present the alleged Constitutional issue in any form ripe for adjudication by this Court, (2) the Congress has the power to pass legislation that in its judgment best effectuates the Constitutional aim of the patent system, including the definition of first inventor, and (3) proposed legislation now in the Congress and supported by the President, if enacted, will render moot any possible question raised on the present record.

Preliminarily, we point out that the ruling below is merely an award of priority of invention to the party Woofter, pursuant to 35 USC 135(a). It is based on the provision of 35 USC 102(g) that one is not entitled to a patent if "before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it." The Court below concluded that the party Carlson forfeited his right to a patent. In so doing, the Court below applied the doctrine of *Mason v. Hepburn,* 13 App. D.C. 86 (1898) which was codified in 1952 as 35 USC 102(g).

There is no conflict of lower court rulings on the question presented. Early disclosure of an invention to the public promotes the progress of the useful arts and the public welfare in accordance with the objects of the Constitution and the acts of Congress, whereas delay, suppression and concealment defeat the purpose of the law.

The doctrine of forfeiture enunciated in *Mason v. Hepburn* has rarely been invoked in the 70 years of its existence due to the stringent standard of proof required by the courts to establish suppression or concealment. The decisions of the Court of Customs and Patent Appeals in the instant controversy and a contemporaneous case of *Engelhardt v. Judd,* 369 F.2d 408 did apply the doctrine.

However, only one case applied the doctrine in the period of almost 60 years since 1908, namely *Miller v. Hayman*, 46 F.2d 188 (CCPA 1931), and only five cases previously applied the doctrine as set out below.*

I

The judgment below was rendered by the Court of Customs and Patent Appeals on an appeal under 35 USC 141 from a Patent Office award of priority in an interference proceeding under 35 USC 135(a). The latter statute directs the Commissioner of Patents to declare an interference whenever one patent application interferes with another. It further provides that the "question of priority of invention shall be determined by a board of patent interferences * * * whose decision, if adverse to the claim of an applicant, shall constitute the final refusal by the Patent Office of the claims involved, and the Commissioner *may* issue a patent to the applicant who is adjudged the prior inventor."** The only ruling made in the present proceedings is that the party Woofter is adjudged to be the first inventor in relation to the party Carlson.

The effect of the ruling below is to deny Carlson a patent. But the petition here raises no issue as to such denial. To the contrary, Carlson takes the position that he is "the first inventor who exposed the invention to the relevant segment of the public, and thus gave the public a vested right" (p. 14). While the party Carlson takes

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* *Gordon v. Wentworth*, 31 App. D.C. 150 (1908)
Bliss v. McElroy, 29 App. D.C. 120 (1907)
Matthes v. Burt, 24 App. D.C. 265 (1904)
Thomson v. Weston, 19 App. D.C. 373 (1902)
Fefel v. Stoker, 17 App. D.C. 317 (1900)

** (Emphasis added.)

liberties with the record facts, it is plain that he does not now seek any holding that he is entitled to a patent. To the contrary, he merely seeks ruling of this Court that on Constitutional grounds Woofter should not have a patent. To the extent the inconclusive language at page 15 of the petition may be otherwise interpreted, the point is made in a manner too obscure to present any clear question of public policy requiring consideration by this Court.

As to the party Woofter, the ruling below is interlocutory. As stated in *Miller v. Hayman,* 41 F. 2d 188, 194 (CCPA, 1931):

> "It must be remembered that patentability of an invention is not involved in an interference proceeding. Whether either party should receive a patent is not for us to determine here. We have to do only with the rights of the parties upon the question of priority of invention, each claiming to be the first inventor under the patent laws."

The Patent Office Rules of Practice set forth the action to be taken in connection with a pending application following an interference determination of priority, namely Rule 266(b):

> "After judgment of priority, the application of any party may be held subject to further examination, including interference with other applications."

Moreover, the Patent Office Rules of Practice specifically provide for inter partes use proceedings where an interested party may challenge the issuance of a patent to another on the ground that the alleged invention has been in public use or on sale more than one year prior to the patent application. Rule 292(a). Under this rule if the petitioner makes out a *prima facie* showing that the inven-

tion claimed in the application "had been in public use or on sale one year before the filing of the application, * * *, a hearing may be had before the Commissioner to determine whether a public use proceeding should be instituted." The Woofter application may be subject to proceedings of this type. A classic example of this procedure is exemplified by *In re Blaisdell,* 242 F. 2d 779 (CCPA, 1957).

This case is not ripe for adjudication by this Court of the alleged Constitutional issue presented, or any Constitutional issue. As pointed out in *Burton v. United States,* 196 U.S. 283, 295 (1905) "It is not the habit of the court to decide questions of a Constitutional nature unless absolutely necessary to a decision of the case." This Court has refused to determine Constitutional issues involving state statutes in the absence of a final construction of the statute by the state courts. *City of Chicago v. Fieldcrest Dairies,* 316 U.S. 168 (1942). As there pointed out the Constitutional issue "may not survive the litigation in the state courts" (316 U.S. at p. 173). In the present instance the ruling below is interlocutory. The alleged Constitutional issue here may not survive further proceedings in the Patent Office or patent enforcement proceedings, if they occur. The time to consider the alleged Constitutional issue is when and if it is unavoidably presented in a truly final ruling, not in the present essentially interlocutory proceeding.

II

The petition assumes that there is some specific Constitutional definition of first inventor, which leaves no room for Congressional declaration on the subject. But the Constitution says nothing about first inventor. Article I, Section 8, Clause 8 says only that—

> "The Congress shall have the power . . . To promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries."

The "first inventor" requirement comes from the statutes, not the Constitution. Thus Section 5 of the 1790 Patent Act (1 Stat. 109) required that the patentee be the "first and true inventor or discoverer" and Section 1 of the 1793 Patent Act (1 Stat. 318) required that the invention be "not known or used before the application."

The rulings of this Court on who is the first inventor have rested upon the statutes, not on Constitutional grounds. The cases relied upon at pages 6-11 of the petition interpret the statutes.

Only last term this Court squarely held that in patent law matters, as well as general law matters, the Congress has the power to "implement the stated purpose of the Framers by selecting the policy which in its judgment best effectuates the constitutional aim" (383 U.S. at p. 6). This Court there upheld the statutory definition of "invention" set forth in 35 USC 103. *Graham v. John Deere,* 383 U.S. 1 (1966). This principle applies even more clearly where, as here, the concept of first inventor is nowhere defined in the Constitution.

Since at least 1836, the patent laws have specifically defined who is to be considered a first inventor. Section 15 of the 1836 Act (5 Stat. 117) denied patent enforceability to one who "had * * * unjustly obtained the patent for that which was in fact invented or discovered by another, who was using reasonable diligence in adapting and perfecting the same." This language plainly allowed patent

enforceability, even to that "which was in fact invented or discovered by another" where the other was not using reasonable diligence.

A more dramatic illustration of Congressional determination of who is to be considered first inventor is found in *Electric Storage Battery Co. v. Shimadzu,* 307 U.S. 5 (1939), and the subsequent events. Based upon the then-existing patent statutes, this Court held in that case that a citizen and resident of Japan could prove his own pre-application date of invention outside the United States to support the validity of his patent. This Court there pointed out that while the ruling was illogical in some respects, it was compelled by the statutes. Congress then amended the patent law to provide that an applicant or patentee may not "establish a date of invention by reference to knowledge or use thereof, or other activity with respect thereto, in a foreign country * * *." 35 USC 104. The law is now clear that a prior inventor in a foreign country does not prevent the issuance of a valid patent to a subsequent inventor in this country. At no time in the *Shimadzu* case or in the legislative consideration of the amending legislation was there any suggestion that the Congress lacked the Constitutional power to legislate on the extent acts in a foreign country may be relied upon to establish invention.

The ruling below is based on the statutory provision of 35 USC 102(g). If, as Petitioner seems to urge, Congress cannot define who is the first inventor in relation to abandonment, suppression, and concealment, it cannot define what foreign acts may be relied upon to show invention (35 USC 104), and cannot otherwise define the matter of who is an inventor (35 USC 103). This Court specifically held in *Graham v. John Deere,* 383 U.S. 1 (1966) that Con-

gress can define who is an inventor by 35 USC 103; there is a history of over 100 years practice and court decision that assumes that Congress can define who is the inventor in relation to other acts such as invention abroad; and until the present petition no one has questioned the power of Congress to legislate as to abandonment, suppression, and concealment. We submit that there is no real Constitutional question warranting consideration by this Court, even if the record clearly, finally, and unavoidably presented such question.

III

On February 21, 1967, President Johnson transmitted to the Congress a proposed "Patent Reform Act of 1967." House Document No. 59. The requested legislation has been introduced by Senator McClellan in the Senate and Congressman Kastenmeier in the House. A principal feature of the bill requested by the President and thus introduced is an adoption by the United States of the "first to file" principle of granting patents in lieu of the existing "first inventor" system. If the "first to file" system is adopted, the question of who is the first inventor becomes immaterial.

Hearings have been held in both the House and the Senate on the proposed legislation. It is being given the most active and serious consideration by the Congress and others concerned with the patent system.

One effect of the "first to file" system will be to abolish all patent interference proceedings. The present case could not possibly arise in the event such a system is adopted. Taking into account the chance that the issue sought to be raised on the present petition may thus become academic, and taking into account that the Constitu-

tional issue sought to be raised has not previously come up in over 175 years of experience with the United States patent system, and further taking into account the interlocutory nature of the ruling sought to be reviewed, we submit that this case is not one that warrants the grant of certiorari.

* * * * *

The petition should be denied.

Respectfully submitted,

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